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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/656,581	09/06/2000	Robert Filepp	IBM-FILEPP ET AL. 012 PCS	9843

7590 01/30/2004

PAUL C. SCIFO
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10 LEE COURT
FRANKLIN SQUARE, NY 11010

EXAMINER

DINH, DUNG C

ART UNIT	PAPER NUMBER
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2153

DATE MAILED: 01/30/2004

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/656,581

Applicant(s)

FILEPP ET AL.

Examiner

Dung Dinh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☒ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) ☐ Other: _____

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DETAILED ACTION***Response to Arguments***

Applicant's reply filed 11/06/03 have been fully considered and are persuasive to negate a public use or on-sale bar.

Applicant had repeated through out the response that the subject matter of claims 1-51 was not implemented in the preferred form of the Prodigy System. The evidence submitted is persuasive that the subject matter currently claimed is not in public use or on-sale⁴ by activities of the applicant prior to the earliest claimed priority date of July 29, 1989. However, the response raises a question of whether applicant conceived or had possession of the claimed invention at the time of the priority date.

Claimed Priorities under 35 USC § 120 Denied

Claims 1-51 are not entitled to the benefit of the priority dates of the parent applications 08/933,500; 08/740,043; 08/158,026; and 07/388,156 because they lack written description support required under 35 USC 112 first paragraph. The subject matter currently claimed are not described in the specifications of the parent applications in such a way as to reasonably convey to one skilled in the

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art that the applicant, at the time the parent applications was filed, had possession of the claimed invention.

"The purpose of the written description requirement is broader than to merely explain how to 'make and use'; the applicant must also convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention." *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). **That is, the disclosure must show he had invented each feature that is included as a claim limitation.** The adequacy of the written description (i.e., the disclosure) is measured from the face of the application; the requirement is not satisfied if one of ordinary skill in the art must first make the patented invention before he can ascertain the claimed features of that invention. Cf. *Martin v. Mayer*, 823 F.2d 500, 505, 3 USPQ2d 1333, 1337 (Fed. Cir. 1987) ("It is not a question of whether one skilled in the art might be able to construct the patentee's device from the teachings of the disclosure [but] whether the application necessarily discloses that particular device." (quoting *Jepson v. Coleman*, 314 F.2d 533, 536, 136 USPQ 647, 649-50 (CCPA 1963))). *New Railhead Man. LLC v. Vermeer Man. Co.*, 63 USPQ2d 1843, 1847 (CA FC 2002) (emphasize added).

The disclosures of the current application and that of the parent applications are essentially identical. Although applicant's responds filed 5/31/02 (paper #7) and 11/19/03 (paper #14) is persuasive regarding enablement for the claimed invention - that is the network architecture disclosed (in this and the parents applications) could enable one skilled in the art to practice the claimed invention. However, the specifications of the parent applications do not set forth in such full, clear, concise, and exact terms to show possession of the claimed invention or that a skilled artisan would recognize applicant was in

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possession of the claimed invention at the time of the priority date.

For the claims to be entitled to the benefit of an earlier application's filing date, each claimed limitation must be expressly, implicitly, or inherently supported in the earlier application. See, e.g. *In Re Robertson*, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) ("To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described ..."); *Hyatt v. Boone*, 47 USPQ2d 1128, 1131 (Fed. Cir. 1998) (When an explicit limitation in a claim "is not present in the written description whose benefit is sought it must be shown that a person of ordinary skill would have understood, at the time the patent application was filed, that the description requires that limitation.").

As per claims 1-6, the parent applications (08/933,500; 08/740,043; 08/158,026; and 07/388,156) do not expressly, implicitly, or inherently describe:

"an advertisement host responsive to a request from the user reception system based on the location designation to select an advertiser host ... , and identify the

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advertiser host as the selected advertiser host to the user reception system, whereby the advertising content from the selected advertiser host is displayed at the user reception system."

Applicant argued that in a simplified embodiment of the disclosed system one skilled in the art would recognize that:

the "high function system" (fig.2 #110) acts as an advertisement host;

the "gateway system" (210) permits user reception to connect to third-party hosts, e.g. advertiser hosts, that are able to supply advertising content;

the ADSLOT is the identification code which "locates" the "high function host", which in turn, identifies user-targeted ad content, which content may be received from the gatewayed advertiser host. (paper #7 pages 7-8).

This argument is not sufficient to meet the written description requirement because the specification never expressly or implicitly discloses the simplified embodiment, nor the simplified embodiment inherent from the system disclosed. The simplified embodiment argued above is not inherent from the specification because the disclosed system does not require the "high function system",

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"gateway" and ADSLOT to operate as argued in the simplified embodiment.

The specification of the parent applications does not provide any written description that suggests the "high system function" selects an advertiser host connected via the gateway 210 to provide advertisement content in response to a request from a user reception system. There is only a brief sentence in the specification that discloses that the gateway 210 permits a connection to outside network. There is no disclosure of what exist on the outside network. There is no written description to support that applicant contemplated such an embodiment.

The disclosure actually teaches away from the simplified embodiment. The disclosed system was aimed at solving the issues of low bandwidth and latency in retrieving data over slow modem link at the user reception systems. All advertisements and contents are pre-stored on the file server 205 with distribution to the cache/concentrator 302 for load balancing and latency reduction. The disclosed system teaches providing a stage file and an advertisement queue on the user system for caching contents. Advertisements are pre-fetched into the advertisement queue to reduce latency and wait time. There

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is no written description that a request from the user system is ever received by the "high function system" 110 or a "gatewayed" third-party host. Any request for content not already on the user system is fulfilled by the cache/concentrator 302 and file server 205. Hence, it is clear that the claimed limitations are not inherent from the disclosure because the limitations are not required from the disclosure. Therefore, claims 1-6 are not entitled to the benefit of filing date of the parent applications (08/933,500; 08/740,043; 08/158,026; and 07/388,156).

As per claims 7-12, 13-18, 32-37, 41-46, and 47-49, are not entitled to the benefit of filing date of the parent applications (08/933,500; 08/740,043; 08/158,026; and 07/388,156) because they lack written description support for the same reason as stated for claim 1 above.

As per claims 19-22, the parent applications do not expressly, implicitly, or inherently describe:

"an advertisement host responsive to a request from the user reception system based on the location designation to select an advertising content ...and to reply to the

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request by identifying the advertising content to the user reception system."

Applicant argued that the "high function system" 110 corresponds to the claimed "advertisement host". There is no written description suggesting that the "high function system" 110 ever receive any user request. There is no written description suggesting that the "high function system" 110 ever receive a user request based a location designation and to response with advertising content.

It is not inherent that the "high function system" 110 received a request from the user reception system because such function is not required from the disclosure. Fig.2 and the disclosure clearly show that the "high function system" 110 only connected to File server 205. There is no communication link from the user reception system to the "high function system" 110. All content requests from the user receptions are fulfilled by the cache/connector 302 or server 205. Hence, it is not inherent that the "high function system" would receive or response to an advertisement request from the user reception system as claimed. Therefore, claim 19 is not entitled to the benefit of filing date of the parent applications (08/933,500; 08/740,043; 08/158,026; and 07/388,156)

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because the written description does not expressly, implicitly, or inherently support claim 19 as recited.

As per claims 23-28, 29-31, 38-40, and 51 are not entitled to the benefit of filing date of the parent applications (08/933,500; 08/740,043; 08/158,026; and 07/388,156) because they lack written description support for the same reason as stated for claim 19 above.

Showing Under 37 CFR 1.608(b)

Since claims 1-51 are not entitled to the benefit of the claimed priority date, the effective filing date is therefore the filing date of the current application - 09/06/2000. The effective filing date of the application is more than 3 months after the effective filing date of the patent that applicant is seeking interference with, 37 CFR 1.608(b) requires that the applicant must file (A) evidence, such as patents, publications and other documents, and one or more affidavits or declarations which demonstrate that applicant is prima facie entitled to a judgment relative to the patentee, and (B) an explanation stating with particularity the basis upon which the applicant is prima facie entitled to the judgment.

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Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-51 are rejected under 35 U.S.C. 102(e) as being anticipated by Merriman et al. US patent 5,948,061.

The rejection cannot be overcome by an affidavit or declaration under 37 CFR 1.131 but only through interference proceedings.

Claims 1-13 read directly onto Merriman claims 1-13.

Claims 14-16 read directly onto Merriman claims 17-19.

Claims 17-18 read directly onto Merriman claims 14-15.

Claim 19 reads directly onto Merriman claim 16.

Claims 20-35 read directly onto Merriman claims 20-35.

Claims 36-37 read directly onto Merriman claims 40-41.

Claims 38-40 read directly onto Merriman claims 42-44.

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Claims 41-46 read directly onto Merriman claims 45-50.

Claims 47-50 read directly onto Merriman claims 36-39.

Claim 51 read directly onto Merriman claim 16.

Claims 1, 3, 7, 13, 15, 32, 34, 41, 43, 47, 48; and 19-20, 23, 29, 38, 50 and 51 are rejected under 35 U.S.C. 102(b) as being anticipated by Kohda et al. "Ubiquitous advertising on the WWW: Merging advertisement on the browser".

As per claim 1, Kohda teaches a network comprising:

a user reception system [fig.2 'browser'], the user reception system providing requests for information on the network [p.1495 col.1 4th paragraph];

a content host [fig.2 Ordinary web server] responsive to the requests for information to provide media content [web page];

an advertiser host [fig.2 Advertiser web server] having an advertiser web site including advertising content;

an advertisement host [fig.2 Advertising agent web server] responsive to a request from the user system to select an advertiser node and identify the advertiser host as the selected advertiser host to the user system [fig.2

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Advertiser's Web server and advertisement web page; p.1495 cols. 1-2, sections 2.2. and 2.3, and pp. 1497-88, section 3.2]; and

whereby the advertising content from the selected advertiser host is displayed at the user node [p.1495 col.1 section 2.2].

As per claims 7, 13, 32, 41, and 47 they are rejected under similar rationale as for claim 1 above.

As per claims 3, 15, 34, 43 and 48, Kohda teaches selecting the advertisement based on user characteristics [p.1495 col.1 5th paragraph - "... tailor advertisements for individuals and their current interests..."].

As per claim 19, Kohda teaches a network comprising:
a user reception system [fig.2 'browser'], the user reception system providing requests for information on the network [p.1495 col.1 4th paragraph];

a content host [fig.2 Ordinary web server] responsive to the requests for information to provide media content [web page];

an advertisement host [fig.2 Advertising agent web server] responsive to a request from the user system to select an advertisement content [fig.2 advertisement web

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page; p.1495 cols. 1-2, sections 2.2. and 2.3, and pp.
1497-88, section 3.2]; and

whereby the advertising content from the advertisement host is displayed at the user node [p.1495 col.1 section 2.2].

Claims 23, 29, 38, and 51 are rejected under similar rationale as for claim 19 above.

As per claims 20 and 50, Kohda teaches the advertisement host identifies an advertiser node [fig.2 Advertiser's Web server] to the user system and the advertiser host delivers advertisement content to the user system [p.1495 cols. 1-2, sections 2.2. and 2.3, and pp. 1497-88, section 3.2].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 2, 8, 14, 24, 33, 42, 49; and 4, 10, 16, 26, 35, 44 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kohda et al. "Ubiquitous advertising on the WWW: Merging advertisement on the browser".

As per claims 2, 8, 14, 24, 33, 42, and 49 Kohda does not specifically disclose selecting the advertiser node based on the number of time the advertising content has been previously display. It would have been obvious for one of ordinary skill in the art to display the advertisement based on the number of time previously display because it would have enable rotation of the advertisement and to fulfill the display rate contracted with the advertiser.

As per claims 4, 10, 16, 26, 35, 44 and 48, Kohda does not specifically disclose the list of user characteristics recited. The type of user characteristics chosen to select the advertisement would have been a matter of design choice because it does not functionally affect the method for retrieving and displaying of the advertisement of claim 17. It would have been obvious for one of ordinary skill in the art to choose one or more characteristics that would enable appropriate matching of the advertisements to the current user.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dung Dinh whose telephone number is (703) 305-9655. The examiner can normally be reached on Monday-Thursday from 7:00 AM - 4:30 PM. The examiner can also be reached on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess can be reached at (703) 305-4792.

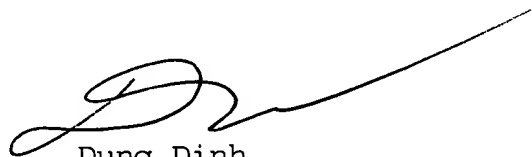
Any inquiry of a general nature or relating to the status of this application should be directed to the Group 2100 Customer Service whose telephone number is (703) 306-5631.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, DC 20231

or faxed to: (703) 872-9306

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Fourth Floor (Receptionist).

A handwritten signature in black ink, appearing to be 'Dung Dinh', with a long, sweeping horizontal line extending to the right.

Dung Dinh
Primary Examiner
January 24, 2004

Interview Summary	Application No.	Applicant(s)	
	09/656,581	FILEPP ET AL.	
	Examiner	Art Unit	
	Dung Dinh	2153	

All participants (applicant, applicant's representative, PTO personnel):

(1) Dung Dinh. (3)_____.

(2) Paul Scifo. (4)_____.

Date of Interview: 23 July 2003.

Type: a) ☒ Telephonic b) ☐ Video Conference
c) ☐ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☐ No.
If Yes, brief description: _____.

Claim(s) discussed: none.

Identification of prior art discussed: none.

Agreement with respect to the claims f) ☒ was reached. g) ☐ was not reached. h) ☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: The double patenting paragraph cited in the office action paper #12 was a mistake. No double patenting was made.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

Examiner's signature, if required